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Timothy N. Trop  
TROP, PRUNER & HU, P.C.  
STE 100  
8554 KATY FWY  
HOUSTON, TX 77024-1805

EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/773,682

### Applicant(s)

BURR, JEREMY

### Examiner

Philip B Tran

### Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This office action is in response to the amendment filed on 09/01/2004. Claims 1, 9, 11, 13, 18, 19, 21, 24, 25 and 29 have been amended. Claim 17 has been canceled. Claims 31-32 have been newly added. Pending claims 1-16 and 18-32 are presented for further examination.

***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-16 and 18-32 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gudjonsson et al (Hereafter, Gudjonsson), U.S. Pat. No. 6,564,261.

Regarding claim 1, Gudjonsson teaches a method comprising:

enabling the storage of a modifiable list of selected second terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that a first terminal is able to communicate with (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46], said list maintained and modified by a first user (= adding or removing users to/from the contact list with authentication) [see Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59]; and

based on said list, enabling communications between a first terminal and second terminals when a second user is using said first terminal (= enabling communication services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46].

Regarding claim 2, Gudjonsson further teaches including communicating between a first terminal and a base station and forwarding communications from said first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] to said base station (= cluster) [see Figs. 1 & 13] on to said second terminals (= other users (7) of clients (11)) (= communication between users and the cluster such as a collection of servers and database) [see Figs. 1 & 13].

Regarding claim 3, Gudjonsson further teaches including enabling communications between a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] and said base station (= cluster) [see Figs. 1 & 13] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 4, Gudjonsson further teaches including communicating between said base station and said second terminals at least in part over the Internet (= the cluster (= a collection of servers and database) communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 5, Gudjonsson further teaches including exchanging text messages between said first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 6, Gudjonsson further teaches including communicating between said first terminal and said selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 7, Gudjonsson further teaches including storing said modifiable list of second terminals in said base station (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46].

Regarding claim 8, Gudjonsson further teaches including blocking communications, from said handheld unit, received by said base station and preventing those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col.

28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 9, Gudjonsson further teaches enabling a requirement for a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 10, Gudjonsson further teaches including requiring a password to initiate an outgoing transmission from said first terminal (= authentication with user identity and password) [see Col. 11, Lines 35-43 and Col. 31, Lines 43-59].

Regarding claim 11, Gudjonsson teaches an article comprising a medium storing instructions that enable a processor-based system to:

enable the storage of a modifiable list of selected second terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that a first terminal is able to communicate with (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46], modification of said list restricted to a first user (= adding or removing users to/from the contact list with authentication) [see Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59]; and

based on said list, enable communications between said first terminal and a selected second terminal when a second user is using said first terminal (= enabling

communication services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46].

Regarding claim 12, Gudjonsson further teaches storing instructions that enable the processor-based system (= cluster) [see Figs. 1 & 13] to communicate with a first terminal and forward communications from said first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] to said second terminal (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 & 13].

Regarding claim 13, Gudjonsson further teaches storing instructions that enable communications with a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 14, Gudjonsson further teaches storing instructions that enable the processor-based system to communicate with said second terminals at least in part over the Internet (= the cluster such as a collection of servers and database communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 15, Gudjonsson further teaches storing instructions that enable the processor-based system to exchange text messages between a first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 16, Gudjonsson further teaches storing instructions that enable the processor-based system to communicate between said first terminal and said selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 18, Gudjonsson further teaches storing instructions that enable the processor-based system to block communications from said handheld unit and prevent those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second



terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 19, Gudjonsson further teaches storing instructions that enable the processor-based system to enable a requirement for a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 20, Gudjonsson further teaches storing instructions that enable the processor-based system to require a password to initiate an outgoing transmission from said first terminal (= authentication with user identity and password) [see Col. 11, Lines 35-43 and Col. 31, Lines 43-59].

Regarding claim 21, Gudjonsson teaches a system comprising:

a processor-based device (= the cluster or a collection of servers and database) [see Figs. 1 & 13]; and

a storage (= database (13)) [see Figs. 1 & 13] coupled to said processor-based device storing instructions that enable the storage of a modifiable list of second terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that a first terminal is able to communicate with (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46], said modifiable list accessible to a first user and not a second user (= adding or removing users to/from the contact list with authentication) [see Col.

27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59], enable communications between said first terminal and a listed second terminals when the second user is using said first terminal (= enabling communication services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46].

Regarding claim 22, Gudjonsson further teaches including a wireless interface (= Wireless Application Protocol (WAP) [see Col. 7, Lines 35-60]. Since wireless application protocol is using, a wireless interface is implemented [see Figs. 1 & 13]).

Regarding claim 23, Gudjonsson further teaches said storage stores instructions that enable said device to communicate with a first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] and forward communications from said first terminal to said second terminal (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 & 13].

Regarding claim 24, Gudjonsson further teaches said storage stores instructions that enable communications between a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 25, Gudjonsson further teaches said storage stores instructions that enable the processor-based device to communicate with said second terminals at least in part over the Internet (= the cluster (= a collection of servers and database) communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 26, Gudjonsson further teaches said storage stores instructions that enable the processor-based system to exchange text messages between a first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 27, Gudjonsson further teaches said storage stores instructions that enable the device to communicate between said first terminal and selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 28, Gudjonsson further teaches said storage stores instructions that enable the device to store said modifiable list of second terminals (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46].

Regarding claim 29, Gudjonsson further teaches said storage stores instructions that enable the device to block communications from said handheld unit and prevent those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 30, Gudjonsson further teaches said storage stores instructions that enable the device to require a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 31, Gudjonsson further teaches including restricting said second user from the ability to modify said list (= adding or removing users to/from the contact list with authentication and accessing contact list with user identity and password) [see Col. 11, Lines 35-45 and Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

Regarding claim 32, Gudjonsson further teaches storing instructions that enable the processor-based system to enable restrictions on the ability of the second user to modify said list (= adding or removing users to/from the contact list with authentication and accessing contact list with user identity and password) [see Col. 11, Lines 35-45 and Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

### ***Response to Arguments***

4. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

Gudjonsson teaches a method and system comprising enabling the storage of a modifiable list of selected second terminals such as contact list or buddy list [see Col. 35, Lines 38-44] that a first terminal is able to communicate with (that is, database (13) contains the contact list for each user) [see Col. 28, Lines 34-46], said list maintained and modified by a first user. For example, Gudjonsson teaches adding or removing users to/from the contact list with authentication [see Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59]. In addition, Gudjonsson further teaches based on said list, enabling communications between a first terminal and second terminals when a second user is using said first terminal. For example, Gudjonsson discloses enabling communication services between users (7) of clients (11) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46].

Applicant argued that "In contrast, according to one implementation of the present invention, a communication protocol particularly amenable to use by children enables communications without the fear that the children will inappropriately

communicate with unauthorized individuals. For example, in an embodiment, a list of authorized individuals that a given child may communicate with may be stored on a communication terminal. Before communications are allowed to proceed over a communication network such as the Internet, a check ensures that the intended recipient or sender is an appropriate authorized recipient or sender. In one embodiment, a password protection scheme may be utilized to prevent the child from adding inappropriate contacts to the list of authorized individuals.”

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., restricting communications based on a list that is not modifiable by a user of his system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, the terms “first terminal”, “second terminal”, “first user”, and “second user” are vague and can be broadly interpreted as the same terminal or user. Therefore, applicant's argument is not persuasive because Gudjonsson teaches the limitations as broadly cited in the independent claims as shown above.

As a result, cited prior art does disclose a system and method as broadly claimed by the applicant. Applicant has still failed to identify specific claimed limitations that would define a clearly patentable distinction over prior arts. Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter recited in independent claims. Dependent claims are also rejected at least by virtue of dependency on

independent claims and by other reasons shown above. Accordingly, claims 1-16 and 18-32 are respectfully rejected.

**Conclusion**

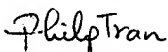
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (571) 272-3978.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Philip Tran  
Art Unit 2155  
November 24, 2004

  
**HOSAIN ALAM**  
SUPERVISORY PATENT EXAMINER